



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/618,578	06/08/84	ROSENTHAL	BA-19850

BUCKNAM AND ARCHER  
600 OLD COUNTRY ROAD  
SUITE 501  
GARDEN CITY, NY 11530

EXAMINER	
ABRAMSON, F	
ART UNIT	PAPER NUMBER
125	3

DATE MAILED: 01/10/85

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.       | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input checked="" type="checkbox"/> <u>Restriction</u>                       |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-13 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-13 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Art Unit 125

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a pharmaceutical composition, classified in Class 424, subclass 204.

II. Claims 8-9, drawn to a process of making a biphosphonic acid of formula I, classified in Class 260, subclass 502.5.

III. Claims 10-12, drawn to a compound of formula I, classified in Class 260, subclass 502.5.

IV. Claim 13, drawn to a halo substituted bisphosphonic acid, classified in Class 260, subclass 502.4.

The inventions are separate and distinct, each from the other because of the following reasons:

These distinct inventions have acquired a separate status in the art and have different fields of search.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case it is obvious that the claimed compounds can be made by a number of different methods. Note, Van Duzee at column 6, lines 20-28.

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Art Unit 125

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications; have acquired a separate status in the art because of their recognized divergent subject matter; and the search required for Group I is not required for Groups II, III or IV restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.


A telephone call was made to Ms. Fiordalisi on December 31, 1984 to request an oral election to the above restriction requirement, but did not result in an election being made.

  
Abramson:ebw

A/C 703

557-3920

1/3/85

  
ALBERT T. MEYERS  
SUPERVISORY PATENT EXAMINER  
ART UNIT 125